

## **REMARKS**

Claims 2-4, 8, 11 and 12 have been canceled. Claim 6 is as originally filed, and claims 9 and 10 are as previously presented.

Claims 1, 5, and 7 have been amended; however, no new matter has been introduced.

Method of use claims 13-15 currently stand withdrawn from consideration as being drawn to a non-elected invention. However, in accordance with MPEP §821.04(b), if Applicants elect claims directed to a product which is subsequently found allowable, the withdrawn process claims which depend from or otherwise require all the limitations of an allowable product claim will be considered for rejoinder. Upon rejoinder of claims directed to a previously non-elected process invention, the restriction requirement between the elected product and rejoined process claims will be withdrawn. It is submitted that the method claims as presented require all the limitations of the elected product (compound) claims. Thus, if the product claims are found allowable, the non-elected method of use claims (withdrawn) should be rejoined.

With these amendments, claims 1, 5-7, 9, and 10 are pending.

### **Rejections under 35 U.S.C. § 112, 2<sup>nd</sup> paragraph**

Claims 1-8, and 10 stand rejected under 35 U.S.C. § 112, 2<sup>nd</sup> paragraph, for allegedly failing to particularly point out and distinctly claim the invention. Applicants respectfully disagree. However, in order to expedite prosecution of the application, Applicants have introduced narrowing amendments to the claims. Applicants submit that the amended claims meet the requirements of the second paragraph of § 112 and respectfully request reconsideration and withdrawal of the § 112, 2<sup>nd</sup> paragraph rejections.

**Rejection under 35 U.S.C. § 103(a)**

Claims 1-10 stand rejected under 35 U.S.C. § 103(a) for allegedly being unpatentable over Maillard *et al.* (WO 02/02512).

The Office asserts that Maillard teaches similar compounds also useful in treatment of Alzheimer's disease. In particular, the Office asserts that the only differences between the compounds of Maillard and the present invention are: (a) the presence of alkyl at position R<sub>1</sub> of Maillard whereas there is a hydrogen at that position in the present invention, and (b) the presence of a substituent on the amine bearing R<sub>N</sub> (e.g., R<sub>1</sub>) in the present invention whereas there is no substituent at that position in Maillard (i.e., a tertiary amine vs. a secondary amine). That is, the Office asserts that the present invention is *prima facie* obvious because "H and alkyl are art recognized equivalents", and that "2° and 3° amines are obvious variants." (Office Action, page 4). Applicants respectfully disagree.

The difference between Maillard and the present invention is not as trivial as the difference between secondary and tertiary amines. First, the compounds of Maillard contain a substituent R<sub>1</sub> in the position alpha to the nitrogen bearing R<sub>N</sub>. The Maillard configuration resembles a natural polypeptide ligand (e.g., -C(O)-NH-CH(R<sub>1</sub>)-). The configuration of the claimed compounds, on the other hand, does not resemble a natural polypeptide ligand (e.g., -C(O)-N(R<sub>1</sub>)-CH<sub>2</sub>-).

Second, it is well known to those in the art that the binding activity of a compound is defined by the catalytic center of the active site. Removing the R<sub>1</sub> ligand from the alpha position of Maillard, and attaching it instead to the amide as in the claimed invention would not be expected to result in the same activity. This is because the binding interactions in the active site are crucial for proper positioning of the substrate or inhibitor. One of ordinary skill in the art would not expect the

compounds which do not resemble a natural polypeptide ligand to have activity, and would not be motivated to prepare such compounds. In other words, one of ordinary skill in the art would not be motivated to prepare and test the claimed compounds which contain a tertiary amide (e.g., do not contain a peptide-like secondary amide). In addition, as shown in the specification, the claimed compounds do show some activity, which, as discussed above, is unexpected considering their non-peptide-like configuration. In view of the foregoing, the compounds of the invention are not *prima facie* obvious with respect to Maillard.

Therefore, applicants respectfully request that the Office withdraw the rejections of these claims based on 35 U.S.C. § 103(a).

Allowance of the claims and passage of the case to issue are respectfully solicited. The Applicants urge the Examiner to contact the Applicants' undersigned representative at (312) 913-0001, if she believes that a discussion would expedite prosecution of this application.

Respectfully submitted,

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